

UNITED STATES PATENT & TRADEMARK OFFICE

Application No. : 09/690,409
Title : APPARATUS FOR APPLYING DRINKING STRAWS
Applicant : Hans-Peter WILD, *et al.*
Filed : October 17, 2000
TC/AU : 3721
Examiner : Thanh K. Truong
Docket No. : 357153/0004

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

APPEAL BRIEF

Sir:

Applicant submits this Brief on Appeal in response to the Office Action of July 15, 2008. A Notice of Appeal was filed on January 15, 2009. The filing of this Brief on Appeal is timely as the due date with payment of appropriate extension fees under 37 C.F.R. 1.136(a) is April 15, 2009. A request for a one month extension of time has been submitted herewith. A Request for Oral Hearing is also submitted herewith. Accordingly, the Commissioner is hereby authorized to

charge the Large Entity Appeal Fee of \$540.00 for filing of this Appeal Brief, \$130.00 for the one month extension, and \$1080.00 for filing the Request for Oral Hearing, and any further fees or deficiencies in fees, to Deposit Account No. 19-4709.

This Appeal is being taken in response to the Office Action, dated July 15, 2008, in which claims 7,9, and 11-14, all of the claims currently pending in the subject Application, have been more than twice rejected. A Notice of Appeal was filed on January 15, 2009.

I. STATEMENT OF THE REAL PARTY IN INTEREST

The real party in interest is:

Deutsche SiSi-Werke GmbH & Co. KG

Rudolf-Wild-Straße 107-115

D-69214 Eppelheim/Heidelberg, Germany

This application has been assigned to Indag Gesellschaft für Industriebedarf mbH by Assignment recorded at Reel 011569 Frames 0709-0710.

II. STATEMENT OF RELATED CASES

The instant case, application no. 09/690,409, was previously appealed. A Notice of Appeal was filed on June 26, 2003. The Board's decision, Appeal No. 2005-2000, mailed to Applicant on July 14, 2006, affirmed the Examiner.

III. JURISDICTIONAL STATEMENT

The Board has jurisdiction under 35 U.S.C. 134(a). The Examiner mailed a final rejection on July 15, 2008, setting a three-month shortened statutory period for response. The time for responding to the final rejection expired on October 15, 2009. 37 C.F.R. 1.134. A notice of appeal was filed on January 15, 2009. A request for a one-month extension of time under 37 C.F.R. 1.17(a)(1) is filed herewith. The time for filing an appeal brief is two months after the filing of a notice of appeal. Bd. R. 41.37(c). The time for filing an appeal brief expired on March 16, 2009 (Sunday, March 15, 2009, being a non-business day). The appeal brief is being filed on April 15, 2009.

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VI. STATUS OF AMENDMENTS

In the Office Action, dated July 15, 2008, claims 7, 9, and 11-14, all of the claims currently pending in the subject Application, were rejected and are being appealed. No Amendment in response to the July 15, 2008 Office Action has been filed. The Office Action was issued in response to an Amendment filed by Applicant on April 11, 2008.

VII. GROUND S OF REJECTION TO BE REVIEWED

Claims 7, 9, and 11-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Geyssel (U.S. Pat. No. 4,584,046) in view of Wild (U.S. Pat. No. 4,572,758).

VIII. STATEMENT OF FACTS

1. The embodiments of the invention as set forth and claimed in independent claims 7, 9, 11, and 13-14 present a novel method and system for applying a drinking straw to the surface of a flexible foil bag filled with a beverage. (OA¹ at 1, ¶ 1, L 1).

2. The claimed method provides a plurality of foil bags filled with a beverage, a plurality of straw packages having an adhesive thereon and a cover

¹ The term "OA" is used hereinafter to refer to the Original Application as filed.

strip covering the adhesive, and a depressing arm capable of being displaced downward. (OA at 3, ¶2, L10; OA Fig. 2). The foil bags are positioned on a conveyor belt such that the bag lays on a side wall on the conveyor belt. (OA at 3, ¶2, L13; OA Fig. 2). As the foil bags are conveyed, the cover strip is removed from the straw packages to expose the adhesive. (OA at 3, ¶2, L8). The depressing arm is then displaced downward toward the conveyor belt, exerting a downward force on the side wall of the straw package and adhesive such that the straw package contacts the surface of a foil bag, thereby affixing the straw package to the foil bag. (OA at 3, ¶2, L10; OA Fig. 2).

3. Claims 7, 9, 11-12 and 14 are directed to a straw package having an adhesive on the straw package, orienting the foil bags in a lying position on the conveyor belt such that a side wall of the bag contacts the conveyor belt, and a depressing arm that is displaceable downward toward the conveyor belt for affixing the straw packages to a side wall of the foil bags lying on the conveyor belt. (OA at 3, ¶2, L10; OA Fig. 2).

4. Claim 7 recites:

providing a plurality of **straw packages having an adhesive thereon** and a cover strip covering the adhesive;

positioning each of the foil bags on a conveyor belt such that the foil bag lies on the conveyor belt on the first side wall, so that the second side wall is at an acute angle with the conveyor belt;

and

rotating the pivoting arm of the lever to **displace the depressing arm downward toward the conveyor belt** to apply one straw package onto the second side wall at an acute angle to the conveyor belt such that the adhesive of the straw package contacts the second side wall.

5. Dependent claim 12, which depends from claim 7, additionally recites:

applying an **adhesive on the straw package** prior to applying the straw package onto the second side wall.

6. Claim 9 recites:

positioning a bag on a conveyor belt such that **the bag lays on the conveyor belt on the first side wall**, and the second side wall is at an acute angle with the conveyor belt;

providing a plurality of straw packages from above the conveyor belt, the **straw packages having an adhesive thereon** and a cover strip covering the adhesive;

and

rotating the pivoting arm of the lever to **displace the depressing arm downward toward the conveyor belt** to apply a straw package to the second side wall at an acute angle with the conveyor belt and substantially parallel to the second side wall such that the adhesive contacts the second side wall.

7. Claim 11 recites:

positioning a foil bag on the conveyor belt such that the foil bag lays on the conveyor belt on a first side wall, so that the second side wall is at an acute angle with the conveyor belt;

providing a plurality of straw packages . . . **the straw package having an adhesive** thereon covered by a cover strip;

and

rotating the pivoting arm of the lever to **displace the depressing arm downward toward the conveyor belt** to apply the straw package onto the second side wall such that the adhesive of the straw package contacts the second side wall while maintaining the straw package substantially parallel to the second side wall.

8. Claim 14 recites:

a conveyor belt constructed and arranged to convey the plurality of **bags with the first side facing up and the second side contacting the conveyor belt;**

a plurality of straw packages connected to one another, the **straw packages having an adhesive thereon**, the adhesive being covered by a removable cover strip;

and

a straw applying member having a **depressing arm** and a pivoting arm, wherein rotating the pivoting arm of the lever **displaces the depressing arm downward toward the conveyor belt**

9. Claim 13 is directed to a straw package having adhesive thereto and a depressing arm that is displaceable downward toward the conveyor belt. Claim 13 recites:

a straw package supplying assembly for supplying a plurality of **straw packages having an adhesive thereon;**

and

a straw applying member having a depressing arm and a pivoting arm, wherein rotating the pivoting arm of the lever **displaces the depressing arm downward toward the conveyor belt**

10. In contrast to the claimed invention discussed above, in beverage container systems that are known in the art, the beverage containers are usually conveyed in an upright position so that the base thereof is positioned on the conveyor. (See, e.g., Geyssel, col 6, row 50; Geyssel Fig. 10). Drinking straws are applied to an upright, sometimes tilted, side wall of the container. (See, e.g., Geyssel col 5, row 45; Geyssel col 6, row 50; Geyssel Figs. 9, 10). Additionally, certain known methods are directed to affixing straw packages onto box type containers, which are made from sturdy materials, such as cardboard. (See, e.g., Geyssel Fig. 1).

11. On the other hand, the flexible foil bags of the claimed invention present notable challenges. (OA at 3, ¶3, L7). For example, because the surface of the foil bag has less structural integrity than the six-sided cardboard container shown in the Geyssel patent (Geyssel Fig. 1) and cannot keep their shape when the foil bag is filled with a beverage, it is more difficult to secure a straw package to the surface. (OA at 3, ¶3, L7). The foil bags to which the method and system of the instant invention are directed, also have a triangular cross section, and hence, are also inherently less balanced than a container that has six sides (for example a traditional cardboard beverage container) when being conveyed on a conveyor belt.

(OA at 1, ¶4, L5). Thus, these features of the foil bag present different problems when a straw package is affixed to the surface to assure that the straw package remains fixed during manufacture, handling, shipping and sale to the consumer.

12. To overcome these challenges, the embodiments of the claimed invention are designed to provide a downward force to affix the straw package to the foil bag, which is preferable to the known methods. (OA at 3, ¶2, L10; Fig. 2). The claimed invention also optimizes the efficiency of affixing straw packages to such flexible foil bags by increasing the speed of production, thereby providing the benefit of an overall higher manufacturing yield. (OA at 2, ¶2-5).

13. This is accomplished by the use of the depressing arm applying a downward force to a straw package having adhesive thereon and onto a foil bag conveyed in a **lying position**, whereby the foil bag lies on the side wall rather than the base. (OA at 3, ¶2, L10). The downward force of the arm applying the straw packages in the direction of gravity, which is preferred to a side force which would require greater force to adhere the straw packages to the foil bag, apart from any issue of whether the adhesive is prefixed on the straw package or on the foil bag, is a different method of applying the straw package to the foil bag than those systems commonly known in the art.

14. In addition, the claimed method and system further increases the speed of production through the claimed design and operation of the depressing arm. (OA at 2, ¶2-5). The use of the claimed depressing arm shortens the movement path of the straw packages and allows the straw packages to be moved in a parallel movement without any angular change. (OA at 2, ¶5, L1). Moreover, positioning the foil bag on its side permits the straw packages to be applied with a depressing arm using a downward force, and hence facilitates speedy production. (OA at 2, ¶2-5; OA at 3, ¶2, L10). Accordingly, the invention as claimed significantly increases the overall rate at which straw packages may be affixed to foil bags. (OA at 2, ¶5, L5).

IX. ARGUMENT

A. REJECTION UNDER 35 U.S.C. §103(A) - U.S. PATENT NO. 4,584,046 TO GEYSSSEL IN VIEW OF U.S. PATENT NO. 4,572,758 TO WILD.

Claims 7, 9, and 11-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,584,046 to Geyssel (hereinafter “Geyssel”) in view of U.S. Pat. No. 4,572,758 to Wild (hereinafter “Wild”). Applicants respectfully submit, however, that the invention claimed by independent claims 7, 9, 11, and 13-14 and dependent claim 12 of the subject application is not obvious in view of Geyssel or Wild, either taken alone or in combination. The claimed

invention is not rendered obvious by any combination of Geyssel and Wild at least because a consideration of the differences between the cited prior art and the claimed invention establish that (1) the Final Rejection fails to establish a *prima facie* case of obviousness; (2) no *prima facie* case of obviousness can be established because there is no reason one of ordinary skill in the art would combine the cited references; and (3) even assuming *arguendo* that it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Geyssel and Wild, neither reference teaches or suggests the invention as claimed. Each of these arguments is set forth below.

1. The Scope Of The Prior Art And Differences Between The Prior Art And The Claimed Invention.

Neither Geyssel nor Wild render the claimed invention obvious because there are substantial differences between both references and the claimed methods and systems for affixing straw packages to containers. Most significantly, neither Geyssel nor Wild, either alone or in combination, teach or suggest each and every element of the claimed invention. Also, neither Geyssel nor Wild solve the problem addressed by the claimed invention.

Geyssel is directed to affixing straw packages onto box type packages, which are inherently made of robust materials in order to have sufficient structural

integrity to maintain their shape (See, e.g., Geyssel Fig. 1), standing in an **upright position** (See, e.g., col 5, row 45; col 6, row 50; Fig. 10), and wherein the **adhesive is placed on the package**, rather than the straw package, prior to application of the straw package (col 5, row 29). The member used to affix straw packages, as explained in Geyssel, is a two-arm tilt lever that pivots about the joining portion of the two arms as a result of a spring urging the two-arm tilt lever to pivot. (col 4, row 63). In another embodiment, Geyssel is directed to a lever that is moved toward and away from the containers in a **lateral movement** (col 2, row 34).

In contrast thereto, claims 7, 9, 11-12 and 14 on appeal recite that the foil bags lay on the conveyor belt and are not in an upright position. Each claim on appeal recites that the adhesive is on the straw package, whereas, in Geyssel, the adhesive is on the beverage container, **not** on the straw package. Finally, each claim on appeal recites that the depressing arm is displaced downward toward the conveyor belt to provide a more rapid speed and preferable force for affixing straw packages to foil bags, a feature that is also not taught or suggested by Geyssel.

Wild, which is assigned to the assignee of this application and is cited as the secondary reference, is directed to a system for simultaneously affixing straw

packages to a **batch of beverage bags** (col 2, row 15; col 6, row 61) by contacting the containers to the straw packages using an **upward motion** of the beverage bags (col 5, row 49). While Wild is directed at placing an adhesive on the straw package prior to the affixation process, it does so to eliminate the need to accurately place the straw package onto precise points of adhesive located on the containers (col 1, row 50). Thus, the instant application is directed to improving the system disclosed and claimed in the Wild patent. The clear difference between the claimed invention, such as lying the bags on their side on a conveyor belt and using a downward motion of the acting arm, represents a different affixation system and method.

Unlike either Geyssel or Wild, claims 7, 9, 11-12 and 14 are directed to orienting the foil bags in a **laying position on the conveyor belt**. Additionally, all the claims on appeal recite a **depressing arm that is displaced downward, toward the conveyor belt** and onto the straw packages with adhesive to affix the straw packages to the foil bags and placing adhesive on the straw packages prior to affixing the straw packages to the foil bags. These attributes provide the benefit associated with using a downward acting force and increasing the production speed of the apparatus.

2. The Final Rejection Fails To Establish A *Prima Facie* Case Of Obviousness Because No Rationale Is Provided That Explains Why The Claimed Invention Would Have Been Obvious To A Person Of Ordinary Skill In The Art At The Time Of The Invention.

To establish a *prima facie* case of obviousness, the cited references must suggest the claimed invention or there must be a reason presented to explain why the claimed invention would be obvious to one of ordinary skill in the art. Pursuant to M.P.E.P. §2142, “the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” M.P.E.P. §2142 (emphasis in original). “If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” *Id.* “The [e]xaminer can satisfy [his burden of establishing a *prima facie* case of obviousness] **only** by showing some objective teaching in the prior art or that the knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *Ex parte Coppeta*, Appeal 20084898, decided Feb. 5, 2009 (citing *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992)) (emphasis added).

Here, the Final Rejection does not articulate a *prima facie* case of obviousness. The Final Rejection does not give any explanation, let alone any

explicit rationale, to support a conclusion of obviousness. The Final Rejection also fails to point to any evidence in either Wild or Geyssel that implicitly or expressly suggests the claimed elements of placing the foil bag in a lying position on a side wall of the bag on the conveyor belt as claimed in claims 7, 9, 11-12, and 14 and a depressing arm delivering a downward force toward the conveyor belt, as claimed in claims 7, 9 11-14. For instance, claim 11 recites in pertinent part:

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply the straw package

and

positioning a foil bag on the conveyor belt such that the foil bag lays on the conveyor belt on a first side wall, so that the second side wall is at an acute angle with the conveyor belt.

Rather than setting forth any logic or reasoning as to why the claimed invention would have been obvious to one of ordinary skill in the art, the Final Rejection merely consists of a listing of elements alleged to be found in the prior art and concludes that

it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geyssel apparatus and method by incorporating the

apparatus and method as taught by Wild to provide a more effective machine and method of attaching drinking straws onto containers. (page 6 of the Final Rejection).

Such a conclusion cannot sustain a *prima facie* case of obviousness. As the Federal Circuit has established, simply stating that “it would have been obvious” is insufficient. “Such generalized claims of what ‘the secondary references’ teach and of what the skilled artisan would have been ‘well aware’ fail to satisfy the level of specificity that is required.” *In re Beasley*, 117 Fed. Appx. 739, 744 (Fed. Cir. 2004).

The Federal Circuit has also emphasized that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *see also KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (quoting *In re Kahn* with approval). The Supreme Court of the United States affirmed this reasoning in *KSR*, stating that the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. *KSR*, 127 S.Ct. at 1741. Moreover, this Board has followed suit and has observed that the Supreme Court in

KSR “did not dispense with the premise that a conclusion of obviousness requires some explicit rationale for practicing the claimed subject matter:”

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Ex parte Coppeta, Appeal 20084898, decided February 5, 2009 (quoting *KSR*, 127 S.Ct. at 1741); *see also Ex parte Zhu*, Appeal 20082138, decided May 19, 2008 (reversing the rejections under 35 U.S.C. §103 because the examiner provided no “apparent reason to combine the known elements in the fashion claimed”); *Ex parte McQuiston*, Appeal 20083224, decided March 6, 2009 (reversing the rejection under 35 U.S.C. §103 because the examiner failed to provide an obviousness rationale); *Ex parte Barnes*, Appeal 20074114, decided Jan. 22, 2009 (reversing the rejection under 35 U.S.C. §103 because the examiner failed to “provide any reason with rational underpinning to explain why [the feature of the claimed invention] would have been obvious”).

Additionally, the M.P.E.P. states that “[t]he key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. §2143. Thus, “[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” M.P.E.P. §2144 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)); *see also* M.P.E.P. §2144-§2144.09 for examples of reasoning supporting obviousness rejections.

Thus, the Final Rejection fails to state every element necessary to establish a *prima facie* case of obviousness. It neither points to any evidence that the art of record themselves suggest the modifications of the claimed invention nor provides any reason a person of ordinary skill in the art would have to combine the teachings of Wild and Geyssel to obtain the claimed invention. Accordingly, as a legal and factual matter, the Final Rejection does not support a rejection under 35 U.S.C. §103, much less a *prima facie* case thereunder.

3. No *Prima Facie* Case Of Obviousness Can Be Established Because There Is No Reason One Of Ordinary Skill In The Art Would Combine Geyssel And Wild To Achieve The Claimed Invention.

Given the specific structure recited in the claims being appealed, it is illogical to conclude that either Wild or Geyssel, or any combination thereof, renders the claimed invention obvious. There is **no reason** that one of ordinary skill in the art would combine Geyssel and Wild to arrive at the claimed invention at least because (1) substantial reconstruction of the art of record would be required to arrive at the claimed invention; and (2) the assertion that Wild cures the defects of Geyssel is illogical because neither are capable of solving the problems affiliated with affixing straw packages to flexible foil bags.

- a. **It would not be obvious to one of ordinary skill in the art to combine Geyssel and Wild because substantial modifications of the Geyssel and Wild would be necessary to achieve the claimed invention.**

The M.P.E.P. provides that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” See M.P.E.P. §2143.01. The Federal Circuit law established that:

We hold, further, that the combination of Jepson with Chinnery et al. is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in Chinnery et al. as well as a change in the basic principles under which the Chinnery et al. construction was designed to operate.

M.P.E.P. §2143.01 (quoting *In re Ratti*, 270 F.2d 810, 981, 123 USPQ 349 (CCPA 1959)).

Here, substantial modification of the art of record would be necessary to achieve the claimed invention, as neither reference has the structural elements that would enable it to operate like and achieve the efficiency and produce the results of the claimed invention. For example, as will be discussed in further depth *infra*, the claimed invention employs a depressing arm that applies a **downward** force on **straw packages having adhesive thereon**, thereby affixing the straw packages to the foil bags. Claims 7, 9, 11-12 and 14 are further directed to affixing straw packages onto flexible foil bags positioned in a **lying position** on a conveyor belt.

Conversely, Geyssel does not teach or suggest such a displacing arm providing such a downward force. Indeed Geyssel is directed to the use of a two-arm tilt lever that pivots about the joining portion of the two arms. However,

neither arm of Geyssel is pivoted as to displace the arm **downward** toward the conveyor belt. Furthermore, Geyssel is directed to affixing straw packages onto packages standing in an **upright position** and wherein the **adhesive is placed on the package** prior to application of the straw package. Thus, to render the teachings of Geyssel capable of carrying out the method as claimed, substantial reconstruction and modification would be necessary to create an arm with the capacity and which is positioned in a manner capable of delivering a **downward** force. Substantial reconstruction and modification would also be necessary to create and integrate a system that would convey the package receiving the straw package in a **lying position**, rather than an upright position as depicted in Geyssel, and to construct and integrate a system for applying the adhesive material to the straw package rather than the package.

Furthermore, Wild not only fails to remedy the defects of Geyssel, but teaches away from the claimed invention. Wild is directed to simultaneously affixing a plurality of straw packages onto a **batch of beverage containers** by bringing the beverage bags **upward** into contact with the straw packages. Wild does not teach or suggest a **depressing arm applying a downward force** to affix straw packages to foil bags placed in the **lying position**. To arrive at the invention

as claimed, substantial reconstruction and modification would be required to integrate an arm capable of delivering a downward force into the system of Wild and to separate the beverage containers so that they may be singularly conveyed on a conveyor belt in a lying position.

- b. **One of ordinary skill in the art would not combine Geyssel and Wild because neither reference solves the problem remedied by the claimed invention.**

In addition to these structural deficiencies, one of ordinary skill in the art would not look to either Geyssel or Wild to produce the claimed invention because the claimed invention solves the exact problem that occurs with both Geyssel and Wild and which both are incapable of addressing without a reconstruction of both methods and systems detailed therein. The systems of Wild and Geyssel simply do not affix a straw package to a bag lying on its side on a conveyor belt using a depressing arm as claimed.

Apart from lacking a depressing arm exerting a downward force onto the straw packages and failing to affix a straw package to a foil bag lying on a side wall on a conveyor belt, Geyssel additionally does not teach or suggest a straw package having adhesive thereon. The Final Rejection concedes this point,

however, states, “Wild provides . . . an adhesive on the straw packages” and concludes that

it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geyssel apparatus and method by incorporating the apparatus and method as taught by Wild to provide a more effective machine and method of attaching drinking straws onto containers. (page 5 of Final Rejection).

However, this conclusion is improper and unsupported by the art of record. It is illogical to look to Geyssel to ascertain the claimed invention. Most prominently, Geyssel is directed to adhesive being placed on sturdy packages rather than the straw packages as claimed. One of ordinary skill in the art would not arrive at the claimed invention by looking to Geyssel because Geyssel does not solve the problems inherent in affixing straw packages having adhesive thereto to a flexible foil bag. Rather, Geyssel teaches away from the claimed invention.

The fact that Wild is directed to placing adhesive on the straw package cannot remedy the defect of Geyssel. Wild, which has the same assignee as the claimed invention, also fails to resolve the problems associated with affixing straw packages onto flexible foil bags on a conveyor belt. It is, thus, likewise illogical

for one of ordinary skill in the art to look to Wild as a remedy when, in fact, the claimed invention is a system that is different from that of Wild. Also, not only would it be illogical for one of ordinary skill in the art to combine Geyssel and Wild, but, even when combined, neither reference teaches or suggests the downward depressing arm or laying the foil bag on a side wall on the conveyor belt of the claimed invention as discussed *supra*.

Viewed inversely, Geyssel also fails to remedy the defects of Wild. As an initial matter, Wild is directed at addressing the concern of accurate placement of straw packages onto adhesive located on containers; not to the method and system for affixing a straw package to a foil bag on a conveyor belt as claimed. For example, Wild discusses the problem of slower production caused by the need for accurate placement of a straw package to a spot of adhesive previously applied to the container (col 1, row 50). However, Wild does not teach or suggest a method of affixing straw packages onto foil bags with a downward force applied by a depressing arm. Moreover, Wild does not teach or suggest orienting the foil bag such that it lies on a conveyor belt on a side wall. Thus, while Wild is directed to an adhesive placed on the straw package, this does not render the claimed invention obvious. To the contrary, that Wild is directed to placing the adhesive

on the straw package, yet does not discuss or disclose a system that is similar to the claimed invention, indicates that Wild can provide no support for a rejection of the claimed invention as being obvious.

Geyssel, as discussed, does not remedy these defects. Thus, it would be illogical for one of ordinary skill in the art to combine Geyssel and Wild when nothing in either Geyssel or Wild teaches or suggests the claimed invention. Accordingly, no *prima facie* case of obviousness can be established.

4. Geyssel In View Of Wild Does Not Render The Claimed Invention Obvious Because No Combination Of Geyssel And Wild Teach Or Suggest Affixing Straw Packages Having An Adhesive Thereon To A Foil Bag Using The Method And Apparatus As Claimed.

Assuming *arguendo* that it would have been obvious for one of ordinary skill in the art to combine Wild and Geyssel and modify their teachings to provide an improved system for affixing drinking straws to foil bags, no combination of Geyssel and Wild renders the claimed invention obvious because the combination of Geyssel and Wild fail to teach or suggest each and every limitation as claimed. The Final Rejection does not cite any reference that teaches or suggests (1) positioning the foil bags so that each bag **lies on a side wall on the conveyor belt** as claimed in claims 7, 9, 11-12 and 14; or (2) the use of a depressing arm that

applies a **downward** force to affix straw packages having adhesive to foil bags as claimed.

- a. **Neither Geyssel nor Wild, or any combination thereof, teach or suggest positioning a foil bag so that it lies on the conveyor belt on a side wall as claimed in claims 7, 9, 11-12, and 14.**

Applicants respectfully submit that neither Geyssel nor Wild teach or suggest transporting the foil bags in a **lying position** on a horizontal conveyor as claimed in claims 7, 9, 11-12 and 14. For example, claim 7 recites:

positioning each of the foil bags on a conveyor belt such that the foil bag **lies on the conveyor belt on the first side wall**, so that the second side wall is at an acute angle with the conveyor belt.

This positioning of the foil bags yields a more efficient method and system for affixing straw packages to foil bags because a foil bag placed in the lying position is capable of receiving a straw package having adhesive with the preferred downward pressure provided by the downward motion of the depressing arm, which facilitates an increase in the speed of production.

On the contrary, neither Geyssel nor Wild are directed to means of affixing straw packages onto containers, whereby the containers lie on a side wall on a conveyor belt at the time the straw packages are affixed thereto. For example,

figure 10 of Geyssel depicts a push rod 68 in the **vertical position** contacting a drinking straw 11 to a **vertical side of the package** 12. Additionally, while Geyssel discusses the topic of angles, Geyssel is directed to changing the angle of the straw applicator to affix straw packages to packages of varying **diagonal directions**. Geyssel does not teach or suggest a depressing arm structured for affixing straw packages with an adhesive on the straw package to a flexible foil bag on a conveyor belt as claimed in claim 13.

Wild similarly does not teach or suggest placing a foil bag in the claimed lying position on a conveyor belt. Wild is directed to a means of simultaneously affixing straw packages to a **batch of beverage bags** (col 7, row 60). Wild discusses an arrangement of beverage bags whereby one half of the batch of bags being affixed with straw packages are slanting in an opposite position to the second half of the batch (col 6, row 17). However, Wild does not teach or suggest placing the beverage bags **in a lying position on a conveyor belt**. Accordingly, claims 7, 9, 11-12, and 14 are patentable over Geyssel and Wild because both Geyssel and Wild, separately or in combination, fail to teach or suggest each and every element of claims 7, 9, 11-12, and 14.

- b. **Claim 13 is also patentable over Geyssel in combination with Wild despite that it does not explicitly recite foil bags lying on their side.**

Additionally, while claim 13 does not explicitly claim the foil bag lying on a side wall on the conveyor belt, the claimed structure is, nonetheless, directed at doing so. For instance, claim 13 recites:

the transfer assembly also including a straw applying member having a depressing arm and a pivoting arm, wherein rotating the pivoting arm of the lever displaces the depressing arm downward toward the conveyor belt to displace a straw package away from the retaining member and to apply the straw package onto one of the plurality of bags.

The downward moving depressing arm would be ineffective if used with a foil bag that is not oriented in the lying position. Thus, claim 13 also contemplates positioning the foil bags such that they are lying on a side wall on the conveyor belt.

As discussed *supra*, neither Geyssel nor Wild are directed to beverage containers which lie on their side on a conveyor belt while straw packages are being affixed to the beverage containers. Accordingly, even assuming it would have been obvious to combine Geyssel and Wild, Geyssel in view of Wild fails to

teach or suggest each and every element of claim 13. Thus, Applicant respectfully submits that claim 13 is patentable over Geyssel in view of Wild.

- c. **Neither Geyssel nor Wild, or any combination thereof, teach or suggest applying a downward force with a depressing arm as claimed.**

Moreover, Geyssel fails to teach or disclose

providing a lever having a depressing arm and a pivoting arm

and

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt

as claimed in claims 7, 9, and 11 or

a straw applying member having a depressing arm and a pivoting arm, wherein rotating the pivoting arm of the lever displaces the depressing arm downward toward the conveyor belt

as claimed in claims 13-14. The claimed invention permits the depressing arm to apply a **downward force**, thereby permitting the gravitational force resulting from the weight of the depressing arm and the force generated by the claimed invention to force the straw package having adhesive onto the foil bag, resulting in a faster and, hence, more efficient, system. These features allow the claimed apparatus to

operate at greater speeds, thereby producing an overall greater manufacturing yield.

Conversely, Geyssel is directed to a two-arm tilt lever that pivots about the joining portion of the two arms as a result of a spring urging the two-arm tilt lever to pivot. Neither arm of Geyssel is rotated in order to displace the arm downward toward the conveyor belt. In another embodiment, Geyssel is directed to a lever that is moved toward and away from the containers in a **lateral** movement. Thus, the invention of Geyssel is incapable of generating the downward motion, and thereby the preferred downward force, as claimed. Accordingly, the levers of Geyssel fail to teach or disclose the invention as claimed, but rather, teaches away from the claimed invention.

Furthermore, Geyssel does not contemplate the need for the improved adhesiveness and advantages associated with the downward motion of the claimed depressing arm because Geyssel is directed to a cardboard container or otherwise sturdy package rather than flexible foil bags. The sturdier, more stable container of Geyssel, which is held merely by a guardrail secured to the conveyor belt (col 6, row 6), does not require a downward, and hence greater, force to be applied to the adhesive in order to maintain the straw package on the surface of the package.

Similarly, Wild does not teach or suggest displacing a depressing arm downward toward a conveyor belt as claimed. Rather, Wild also teaches away from the claimed invention because Wild is directed to a means of affixing straw packages onto beverage containers by biasing a batch of beverage containers **upwards** against the exposed adhesive on the straw packages (col 5, row 51). Wild also discusses positioning individual straw packages proximate to the beverage container. However, Wild does not teach or suggest the use of a depressing arm applying a **downward** force to a straw package having adhesive in order to affix the straw package to a foil bag. The motion and downward direction of the depressing arm toward the conveyor belt clearly provide a preferred pressure to the straw package and adhesive rather than merely placing the container in contact with the adhesive. Accordingly, Wild, which also fails to teach or suggest an apparatus capable of utilizing a downward force as claimed, does not remedy the defects of Geyssel.

B. CONCLUSION

Applicants respectfully submit that no *prima facie* case of obviousness has been established based on Geyssel in view of Wild because the Final Rejection fails to demonstrate that it would have been obvious for persons of ordinary skill in

the art to modify Geyssel and Wild to obtain the invention as claimed. At least for the reasons above, Applicants respectfully maintain that the invention as claimed is patentable.

Applicants respectfully submit that claims 7, 9, and 11-14 in light of the arguments set forth above are in condition for immediate allowance. Accordingly, Applicants respectfully request that the rejections be reversed and the claims allowed to issuance.

Applicants authorize the Commissioner to charge any new and additional fees or charges, including any fees for a petition for an extension of time, to Deposit Account No. 19-4709, if necessary.

Respectfully submitted,

By:

A handwritten signature in black ink, appearing to read 'S. B. Pokotilow', is written over a horizontal line.

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X. APPENDIX

A. CLAIMS SECTION

1-6 (Cancelled)

7. (Rejected) A method of attaching a straw package to a foil bag having a triangular cross section, the method comprising:

providing a plurality of foil bags having a base and a first side wall comprising a first film and a second side wall comprising a second film, the first wall being connected to the second wall at an acute angle therewith, the first film including a plurality of first side edges overlapping and adhered to a plurality of second side edges of the second film, the first film having a first top edge connected to a second top edge of the second film, the base being connected to a bottom edge of the first film and to a bottom edge of a second film; wherein the foil bags are constructed to stand with the base located toward the bottom of the foil bag;

providing a plurality of straw packages having an adhesive thereon and a cover strip covering the adhesive;

positioning each of the foil bags on a conveyor belt such that the foil bag lies on the conveyor belt on the first side wall, so that the second side wall is at an acute angle with the conveyor belt;

removing the cover strip from the plurality of straw packages and exposing the adhesive;

providing a lever having a depressing arm and a pivoting arm;

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply one straw package onto the second side wall at an acute angle to the conveyor belt such that the adhesive of the straw package contacts the second side wall.

8. (Cancelled)

9. (Rejected) A method of attaching a straw package to a bag having a first rectangular film piece connected to a second rectangular film piece along three edges thereof, the foil bag also having a base connected to a bottom edge of the first rectangular film piece and to a bottom edge of the second rectangular film piece such that the foil bag has a triangular cross section, the method comprising:

providing a plurality of bags having a base, a first side wall and a second side wall, wherein the first side wall and the second side wall share at least two edges, and the bags are constructed to stand on the base;

positioning a bag on a conveyor belt such that the bag lays on the conveyor belt on the first side wall, and the second side wall is at an acute angle with the conveyor belt;

providing a plurality of straw packages from above the conveyor belt, the straw packages having an adhesive thereon and a cover strip covering the adhesive;

providing a lever having a depressing arm and a pivoting arm;

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply a straw package to the second side wall at an acute angle with the conveyor belt and substantially parallel to the second side wall such that the adhesive contacts the second side wall.

10. (Cancelled)

11. (Rejected) A method of attaching a straw package to a foil bag having a first rectangular film piece connected to a second rectangular film piece along three edges thereof, the foil bag also having a base connected to a bottom

edge of the first rectangular film piece and to a bottom edge of the second rectangular film piece such that the foil bag has a triangular cross section, the method comprising:

providing a plurality of foil bags having a base and a first side wall comprising a first film and a second side wall comprising a second film, the first wall being connected to the second wall at an acute angle therewith, the first film including a plurality of first side edges overlapping and adhered to a plurality of second side edges of the second film, the first film having a first top edge connected to a second top edge of the second film, the base being connected to a bottom edge of the first film and to a bottom edge of a second film; wherein the bags are constructed to stand with the base located toward the bottom of the bag;

positioning a foil bag on the conveyor belt such that the foil bag lays on the conveyor belt on a first side wall, so that the second side wall is at an acute angle with the conveyor belt;

providing a transfer drum above the conveyor belt, the transfer drum being rotatable about an axis substantially parallel to the second side wall;

providing a plurality of straw packages on the periphery of the transfer drum, a straw package being positioned substantially parallel to the second side wall, the straw package having an adhesive thereon covered by a cover strip;

providing a lever having a depressing arm and a pivoting arm;

removing the cover strip and exposing the adhesive; and

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply the straw package onto the second side wall such that the adhesive of the straw package contacts the second side wall while maintaining the straw package substantially parallel to the second side wall.

12. (Rejected) The method of claim 7, further comprising applying an adhesive on the straw package prior to applying the straw package onto the second side wall.

13. (Rejected) An apparatus for applying straw packages onto bags having a first rectangular film piece connected to a second rectangular film piece along three edges thereof, the foil bag also having a base connected to a bottom edge of the first rectangular film piece and to a bottom edge of the second rectangular film piece such that the foil bag has a triangular cross section, the apparatus comprising:

a conveyor belt constructed and arranged to convey a plurality of bags;

a straw package supplying assembly for supplying a plurality of straw packages having an adhesive thereon;

a transfer assembly positioned above the conveyor belt,

the transfer assembly constructed and arranged to receive a plurality of straw packages from the straw package supply assembly,

the transfer assembly having a straw retaining member constructed and arranged to retain the straw packages at an acute angle to the conveyor belt such that the adhesive faces the conveyor belt, the transfer assembly also including a straw applying member having a depressing arm and a pivoting arm, wherein rotating the pivoting arm of the lever displaces the depressing arm downward toward the conveyor belt to displace a straw package away from the retaining member and to apply the straw package onto one of the plurality of bags.

14. (Rejected) A system for applying straw packages onto foil bags having a triangular cross section, the system comprising:

a plurality of bags having a first side having a first film having a rectangular shape and a second side having a second film having a rectangular shape,

wherein the first film includes a plurality of first side edges, a first top edge and a first bottom edge, the second film includes a plurality of second side edges, a second top edge and a second bottom edge, and wherein the first film overlaps and is adhered to the second film proximate the first side edges,

wherein the first top edge is connected to the second top edge;

the plurality of bags further having a base connected to the first film and the second film proximate the first bottom edge and the second bottom edge, wherein the bags are constructed and arranged to stand on the base;

the plurality of bags having a cross section having a triangular shape defined by the first side, the second side and the base;

a conveyor belt constructed and arranged to convey the plurality of bags with the first side facing up and the second side contacting the conveyor belt;

a plurality of straw packages connected to one another, the straw packages having an adhesive thereon, the adhesive being covered by a removable cover strip;

a transfer assembly positioned above the conveyor belt, the transfer assembly having

a straw retaining member constructed and arranged to receive and retain the straw packages substantially parallel to the first side of the bags,

a disconnecting member to disconnect one straw package from the plurality of straw packages, and

a straw applying member having a depressing arm and a pivoting arm, wherein rotating the pivoting arm of the lever displaces the depressing arm downward toward the conveyor belt to displace a straw package away from the retaining member and to apply the straw package onto one of the plurality of bags on the conveyor belt such that the straw package is attached to the bag via the adhesive.

B. CLAIM SUPPORT AND DRAWING ANALYSIS SECTION

1-6 (Cancelled)

7. (Rejected) A method of attaching a straw package {9a} to a foil bag {3} having a triangular cross section, the method comprising:

providing a plurality of foil bags {3} having a base and a first side wall comprising a first film and a second side wall comprising a second film, the first wall being connected to the second wall at an acute angle therewith, the first film including a plurality of first side edges overlapping and adhered to a plurality of second side edges of the second film, the first film having a first top edge connected to a second top edge of the second film, the base being connected to a bottom edge of the first film and to a bottom edge of a second film; wherein the foil bags are constructed to stand with the base located toward the bottom of the foil bag; {OA at page 1, ¶ 4}

providing a plurality of straw packages having an adhesive thereon {9, 9a} and a cover strip covering the adhesive {11}; {OA at page 3, ¶ 2}

positioning each of the foil bags {3} on a conveyor belt {4} such that the foil bag lies on the conveyor belt {4a} on the first side wall, so that the second side wall {3a} is at an acute angle with the conveyor belt; {OA at page 3, ¶ 1-2}

removing the cover strip {11} from the plurality of straw packages {9a} and exposing the adhesive; {OA at page 3, ¶ 2}

providing a lever having a depressing arm {14} and a pivoting arm {15}; {OA at page 3, ¶ 2}

rotating the pivoting arm {15} of the lever to displace the depressing arm {14} downward toward the conveyor belt to apply one straw package {9a} onto the second side wall {3a} at an acute angle to the conveyor belt {4} such that the adhesive of the straw package contacts the second side wall {3a}. {OA at page 3, ¶ 2}

8. (Cancelled)

9. (Rejected) A method of attaching a straw package {9a} to a bag {3} having a first rectangular film piece connected to a second rectangular film piece along three edges thereof, the foil bag also having a base connected to a bottom edge of the first rectangular film piece and to a bottom edge of the second rectangular film piece such that the foil bag has a triangular cross section, the method comprising: {OA at page 1, ¶4}

providing a plurality of bags {3} having a base, a first side wall and a second side wall, wherein the first side wall and the second side wall share at least two edges, and the bags are constructed to stand on the base; **{OA at page 1, ¶ 4}**

positioning a bag {3} on a conveyor belt {4} such that the bag lays on the conveyor belt {4a} on the first side wall, and the second side wall {3a} is at an acute angle with the conveyor belt; **{OA at page 3, ¶ 2}**

providing a plurality of straw packages {9, 9a} from above the conveyor belt {4}, the straw packages having an adhesive thereon {9a} and a cover strip {11} covering the adhesive; **{OA at page 3, ¶ 2; OA at page 4, ¶ 2}**

providing a lever having a depressing arm {14} and a pivoting arm {15}; **{OA at page 3, ¶ 2}**

rotating the pivoting arm {15} of the lever to displace the depressing arm downward toward the conveyor belt {4a} to apply a straw package {9a} to the second side wall {3a} at an acute angle with the conveyor belt {4} and substantially parallel to the second side wall {3a} such that the adhesive contacts the second side wall {3a}. **{OA at page 3, ¶ 2}**

10. (Cancelled)

11. (Rejected) A method of attaching a straw package {9a} to a foil bag {3} having a first rectangular film piece connected to a second rectangular film piece along three edges thereof, the foil bag also having a base connected to a bottom edge of the first rectangular film piece and to a bottom edge of the second rectangular film piece such that the foil bag has a triangular cross section, the method comprising: {OA at page 1, ¶4}

providing a plurality of foil bags {3} having a base and a first side wall comprising a first film and a second side wall comprising a second film, the first wall being connected to the second wall at an acute angle therewith, the first film including a plurality of first side edges overlapping and adhered to a plurality of second side edges of the second film, the first film having a first top edge connected to a second top edge of the second film, the base being connected to a bottom edge of the first film and to a bottom edge of a second film; wherein the bags are constructed to stand with the base located toward the bottom of the bag; {OA at page 1, ¶ 4}

positioning a foil bag {3} on the conveyor belt {4} such that the foil bag lays on the conveyor belt on a first side wall, so that the second side wall {3a} is at an acute angle with the conveyor belt; **{OA at page 3, ¶ 2}**

providing a transfer drum {6} above the conveyor belt {4}, the transfer drum being rotatable about an axis substantially parallel to the second side wall {3a}; **{OA at page 3, ¶ 2}**

providing a plurality of straw packages {9} on the periphery of the transfer drum, a straw package {9a} being positioned substantially parallel to the second side wall, the straw package {9a} having an adhesive thereon covered by a cover strip {11}; **{OA at page 3, ¶ 2}**

providing a lever having a depressing arm {14} and a pivoting arm {15}; **{OA at page 3, ¶ 2}**

removing the cover strip {11} and exposing the adhesive; and **{OA at page 3, ¶ 2; OA at page 4, ¶ 2}**

rotating the pivoting arm {15} of the lever to displace the depressing arm {14} downward toward the conveyor belt {4a} to apply the straw package onto the second side wall {3a} such that the adhesive of the straw package {9a} contacts

the second side wall {3a} while maintaining the straw package substantially parallel to the second side wall {3a}. {OA at page 3, ¶ 2}

12. (Rejected) The method of claim 7, further comprising applying an adhesive on the straw package {9a} prior to applying the straw package onto the second side wall {3a}. {OA at page 3, ¶ 2}

13. (Rejected) An apparatus for applying straw packages {9, 9a} onto bags {3} having a first rectangular film piece connected to a second rectangular film piece along three edges thereof, the foil bag also having a base connected to a bottom edge of the first rectangular film piece and to a bottom edge of the second rectangular film piece such that the foil bag has a triangular cross section, the apparatus comprising: {OA at page 1, ¶4}

a conveyor belt {4} constructed and arranged to convey a plurality of bags {3}; {OA at page 3, ¶ 1-2}

a straw package supplying assembly for supplying a plurality of straw packages {9, 9a} having an adhesive thereon; {OA at page 3, ¶ 2}

a transfer assembly {5} positioned above the conveyor belt {4}, {OA at page 3, ¶ 2}

the transfer assembly {5} constructed and arranged to receive a plurality of straw packages {9, 9a} from the straw package supply assembly {OA at page 3, ¶ 2}

the transfer assembly {5} having a straw retaining member {6} constructed and arranged to retain the straw packages at an acute angle to the conveyor belt {4} such that the adhesive faces the conveyor belt {4a}, the transfer assembly {5} also including a straw applying member having a depressing arm {14} and a pivoting arm {15}, wherein rotating the pivoting arm {15} of the lever displaces the depressing arm {14} downward toward the conveyor belt {4a} to displace a straw package away from the retaining member {6} and to apply the straw package {9a} onto one of the plurality of bags {3}. {OA at page 3, ¶ 2}

14. (Rejected) A system for applying straw packages {9, 9a} onto foil bags {3} having a triangular cross section, the system comprising:

a plurality of bags {3} having a first side having a first film having a rectangular shape and a second side having a second film having a rectangular shape, {OA at page 1, ¶ 4}

wherein the first film includes a plurality of first side edges, a first top edge and a first bottom edge, the second film includes a plurality of

second side edges, a second top edge and a second bottom edge, and wherein the first film overlaps and is adhered to the second film proximate the first side edges,

{OA at page 1, ¶ 4}

wherein the first top edge is connected to the second top edge;

{OA at page 1, ¶ 4}

the plurality of bags {3} further having a base connected to the first film and the second film proximate the first bottom edge and the second bottom edge, wherein the bags are constructed and arranged to stand on the base; {OA at

page 1, ¶ 4}

the plurality of bags {3} having a cross section having a triangular shape defined by the first side, the second side and the base; {OA at page 1, ¶ 4}

a conveyor belt {4} constructed and arranged to convey the plurality of bags {3} with the first side {3a} facing up and the second side contacting the conveyor belt; {OA at page 3, ¶ 2}

a plurality of straw packages {9a} connected to one another {9}, the straw packages {9a} having an adhesive thereon, the adhesive being covered by a removable cover strip {11}; {OA at page 3, ¶ 2}

a transfer assembly {5} positioned above the conveyor belt {4}, the transfer assembly {5} having {OA at page 3, ¶ 2}

a straw retaining member {6} constructed and arranged to receive and retain the straw packages {9, 9a} substantially parallel to the first side of the bags {3a}, {OA at page 3, ¶ 2; OA at page 4, ¶ 2}

a disconnecting member {10} to disconnect one straw package {9a} from the plurality of straw packages {9}, and {OA at page 3, ¶ 2}

a straw applying member {14, 15} having a depressing arm {14} and a pivoting arm {15}, wherein rotating the pivoting arm {15} of the lever displaces the depressing arm {14} downward toward the conveyor belt {4a} to displace a straw package {9a} away from the retaining member {6} and to apply the straw package {9a} onto one of the plurality of bags {3} on the conveyor belt {4} such that the straw package {9a} is attached to the bag {3} via the adhesive. {OA at page 3, ¶ 2}

C. MEANS OR STEP PLUS FUNCTION ANALYSIS SECTION

NONE.

D. EVIDENCE SECTION

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2. Affidavits And Declarations Relied Upon By Appellant

NONE.

3. Other Evidence Relied Upon By Appellant

a. U.S. Pat. No. 4,584,046 to Geyssel

b. U.S. Pat. No. 4,572,758 to Wild

4. Evidence Relied Upon By Appellant And Admitted Into The File

NONE.

E. Related Cases Section

1. *Ex parte Wild*, Appeal 2005-2000, mailed July 14, 2006.

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

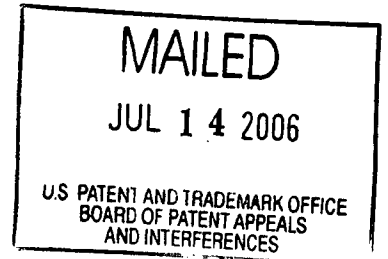
**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HANS-PETER WILD and EBERHARD KRAFT

Appeal No. 2005-2000
Application No. 09/690,409

ON BRIEF

Before GARRIS, WALTZ, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.



DECISION ON APPEAL

This appeal involves claims 1-6, all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to an apparatus for applying a drinking straw to a stand up bag. Claim 1 is illustrative of the subject matter on appeal:

1. In an apparatus for applying a drinking straw to a receiving surface of a stand up bag which is supplied on a conveying surface to a transfer means for drinking straws, the improvement comprising that the stand up bag lies with a side surface resting on the conveyor surface that is generally opposite said receiving surface (3a) and that said transfer means (5) is arranged such that the drinking straw (2) while being handed over encloses an acute angle (α) with the conveying surface (4a).

The Examiner rejects claims 1-6 under 35 U.S.C. § 102(b). According to the Examiner, the claims are anticipated by US Patent 4,584,046 issued to Geyssel on April 22, 1986 (Geyssel).

In reviewing this rejection, we consider the issues as presented in the resubmitted Brief filed November 5, 2003 (Brief), the Answer, and the Reply Brief. Appellants state that claims 1-4 stand or fall together and that each of claims 5 and 6 stand or fall separately (Brief, p. 4). We select claim 1 to represent the issues on appeal for the first group. To the extent that claims 5 and 6 are argued separately, we consider them separately.

We affirm with respect to all the claim groupings for the reasons advanced by the Examiner and add the following for emphasis.

OPINION

The Examiner's rejection is based upon the finding that Geyssel describes an apparatus for applying a drinking straw to a package, the apparatus including a transfer means (Fig. 9) that rotates a transfer drum 20 which applies a straw 11 to a package 12 as the package travels on a conveying surface 13. The Examiner finds that the transfer means is arranged so that the drinking straw, while being handed over, encloses an acute angle with the conveying surface as claimed.

With respect to claim 1, Appellants make the following argument:

Independent claim 1 recites that "the stand up bag lies on a side surface resting on the conveyor surface that is generally opposite said receiving surface." The conveyor surface is that which moves the stand up bag through the apparatus. The receiving surface is that surface upon which the drinking straw is placed. The surface on which the bag lies is the surface **opposite** the straw receiving surface. Geyssel fails to disclose or suggest at least this limitation of independent claim 1. Claim 1 also recites that "the drinking straw (2) while being handed over encloses an acute angle (a) with the conveying surface (4a)." Geyssel fails to disclose or suggest this limitation of claim 1, when considered in light of the other recited surfaces.

(Brief, p. 5).

The Examiner responds that the receiving surface of the package 12 is "generally opposite" the surface that is resting on the conveyor and forming an acute angle with the conveying surface (Answer, p. 3). The Examiner further responds that the apparatus of Geyssel is described as tiltable about two perpendicular axes and that the straws can be secured in different directions and on various inclined surfaces of the package (Answer, p. 4). The Examiner further points out that the apparatus of

Geyssel is capable of attaching straws to a range of articles including packages, bottles, bags, etc (Answer, p. 4 citing Geyssel, col. 1, ll. 42-45). Lastly, the Examiner notes that the claims are directed to an apparatus and that the intended use of the apparatus does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Answer, p. 4).

We agree with the Examiner. As pointed out by the Examiner, the claim is directed to an apparatus. This apparatus is recited as including two structures: (1) a conveying surface; and (2) a transfer means. The stand up bag and the drinking straws are articles worked upon by the apparatus and are not a part of the apparatus itself. When interpreting claim 1 it is proper to consider the language relating to the configuration and position of the bag and straws to the extent that the language further limits the structure of the combination of the conveying surface and transfer means of the claim. The article itself, however, is not considered a part of the apparatus. See *In re Rishoi*, 197 F.2d 342, 345, 94 USPQ 71, 73 (CCPA 1952)("[T]here is no patentable combination between a device and the material upon which it works."); *In re Hughes*, 49 F.2d 478, 479, 9 USPQ 223, 224 (CCPA 1931)(A person may not patent a combination of a device and the material upon which the device works, nor limit other persons from the use of similar material by claiming a device patent. If the material which appellant uses here for printing is new to the art, then such material may be patentable; but he may not take advantage of this in applying for a patent upon a mechanism to apply it. Any feature of the mechanism which is particularly constructed

for the use of such a fluid might be patentable in combination or otherwise. Appellant cannot, however, properly claim a combination of device and material worked upon.); *In re Smith*, 36 F.2d 302, 303, 3 USPQ 315, 316 (CCPA 1929)(It might be argued that the invention here consists in a combination of extra length carbons with the old machine, and that such a combination is patentable. It will be borne in mind that it has been long established that a person may not patent a combination of device and material upon which the device works, nor limit other persons from the use of similar material by claiming a device patent.).

Given the above law with regard to claim interpretation, claim 1 does not require the presence of a bag laying on its side. That does not mean that the claim recitation directed to the orientation of the bag is meaningless, it simply means that it is only considered to the extent that it limits the structure of the apparatus. One way to identify how the claim recitation affects the structure is to consider whether the prior art apparatus is capable of applying a straw to such a bag. We agree with the Examiner that the apparatus of Geyssel is capable of applying a straw to a stand up bag lying on its side such that the straw is on the generally opposite side. This is because, as pointed out by the Examiner, Geyssel describes a pivot point 16 shown in Figure 1 and Geyssel further discloses that the applicator element (transfer drum) can be placed in any desired angular position against the objects (bags) to which the articles (straws) are to be secured (Geyssel, col. 2, ll. 19-32). Moreover, Figure 9 depicts an acute angle between the transfer means (transfer drum or wheel 20) and the conveying device 13.

Through the tilt mechanism, this apparatus is capable of applying a straw to the claimed “generally opposite” side of a stand up bag lying on its side as claimed.

We also agree with the Examiner’s reasoning that the placement of the stand up bag on its side on the conveyor reflects an intended use of the apparatus. How an apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of what is claimed. *Ex parte Masham*, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987); see also *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein.

With respect to claims 5 and 6, Appellants arguments are directed to the configuration of the stand up bag. These arguments fail for the reasons discussed above.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-6 under 35 U.S.C. § 102(b) is AFFIRMED.

AFFIRMED

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